

ESTTA Tracking number: **ESTTA534986**Filing date: **04/29/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SHIFT Communications, Inc.		
Entity	Corporation	Citizenship	Massachusetts
Address	275 Washington Street Newton, MA 02458 UNITED STATES		

Attorney information	Carolina Avellaneda McCarter & English, LLP 265 Franklin Street Boston, MA 02110 UNITED STATES cavellaneda@mccarter.com, elyons@mccarter.com, lshyavitz@mccarter.com, dlynch@mccarter.com Phone:(617) 449-6500
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Applicant Information

Application No	85775791	Publication date	04/23/2013
Opposition Filing Date	04/29/2013	Opposition Period Ends	05/23/2013
Applicant	GraphEffect, Inc. 1447 Cloverfield Blvd. Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. All goods and services in the class are opposed, namely: Providing an online collaboration platform that enables multiple users to work together from different locations

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SHIFT		
Goods/Services	Integrated communications agency services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SHIFT COMMUNICATIONS		
Goods/Services	Integrated communications agency services		

Attachments	Notice of Opposition - SHIFT COM (Serial No 85-775791).pdf (11 pages) (39668 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Carolina Avellaneda/
Name	Carolina Avellaneda
Date	04/29/2013

SHIFT COMMUNICATIONS, INC.,	:	Mark: SHIFT.COM
	:	Serial No. 85/775,791
Opposer,	:	
	:	
-vs-	:	
	:	<u>NOTICE OF OPPOSITION</u>
GRAPHEFFECT, INC.,	:	
	:	
Applicant.	:	
	:	

1. Opposer has provided integrated communications agency services to consumer, technology, media and healthcare companies in the United States since at least as early as 2003. Among the services it is well known to provide, Opposer plans and executes social media marketing programs on behalf of its clients, including: the creation and dissemination of content used in social media channels (Facebook, Twitter, *et al.*); execution of social media advertising programs; monitoring and responding to consumers on behalf of clients, in social media channels; training corporate end-users on how-to conduct social media marketing campaigns;

developing clients' social media outposts, *e.g.*, creating and managing their Facebook pages and subsequent campaigns; *etc.*

2. Since at least as early as 2003, Opposer has continuously provided integrated communications agency services in the United States in connection with marks consisting of or including the term SHIFT, including SHIFT and SHIFT COMMUNICATIONS (collectively, the "SHIFT Marks") and maintains a website at www.shiftcomm.com.

3. By reason of Opposer's extensive promotion, advertising, and provision of high-quality services in conjunction with the SHIFT Marks, the public and the trade have come to recognize services offered in conjunction with these marks as signifying Opposer and its integrated communications agency services.

4. Upon information and belief, Applicant is doing business as SHIFT and focuses on social media marketing services.

5. Upon information and belief, Applicant has maintained a website located at www.shift.com and a Facebook page located at www.facebook.com/starttheshift since at least as early as October 2012.

6. Applicant states on its website that "SHIFT's Open Marketing Cloud offers a suite of best-in-class marketing technology, providing marketers and agencies a single platform and app ecosystem to manage, execute and work together throughout the lifecycle of a marketing plan. SHIFT's Open Marketing Cloud apps reach across the entire marketing stack, from media buying to data management to content creation - and includes GraphEffect, SHIFT's proprietary social advertising app."

7. In approximately October 2012, Opposer's Chief Executive Officer, Todd Defren, became aware of Applicant and placed a Wall Post on Applicant's Facebook page requesting a conversation to discuss the problematic mark, which, upon information and belief, Applicant deleted. Mr. Defren also sent a follow-up note to Applicant via Facebook's private messaging service and an email was also sent to Applicant (via the legal@shift.com email address listed on the site) to inform Applicant of Opposer's prior rights in the SHIFT mark in connection with related services, and to invite Applicant to open a dialogue with Opposer. Applicant ignored Opposer's entreaties.

8. On November 9, 2012, several weeks after Mr. Defren notified Applicant of Opposer and Opposer's prior rights in the SHIFT Marks, Applicant filed the application that is the subject of this Opposition with the United States Patent and Trademark Office ("PTO"), Serial No. 85/775,791, for the registration of the mark SHIFT.COM for "Providing an online collaboration platform that enables multiple users to work together from different locations" in International Class 42, based on an intent to use ("Applicant's Mark"). Applicant's Mark was published for opposition in the Official Gazette on April 23, 2013.

9. As a part of Applicant's application to register Applicant's Mark, filed on November 9, 2012, Applicant submitted a sworn declaration to the PTO in which Applicant stated that to the best of Applicant's knowledge and belief, no other person or entity has the right to use Applicant's Mark in commerce, in an identical or confusingly similar form (the "Declaration").

10. Applicant, however, applied for the registration of Applicant's Mark with full knowledge of Opposer's rights.

11. There is no issue as to priority. Opposer first used the SHIFT Marks at least as early as 2003. This date is long before the date on which Applicant filed its application for Applicant's Mark under Section 1(b) of the Trademark Act, namely, November 9, 2012. Therefore, at the time Applicant sought to register Applicant's Mark, the SHIFT Marks were already in use in the United States.

12. Upon information and belief, Applicant did not use Applicant's Mark for the services covered in the application for Applicant's Mark in United States commerce prior to Applicant's constructive first use date of November 9, 2012.

13. Upon information and belief, Applicant did not use Applicant's Mark for the services covered in the application for Applicant's Mark in United States commerce in 2003 or earlier.

14. In approximately February 2013, Mr. Defren communicated through Facebook with a former employee of Opposer, Devan Fearman. Ms. Fearman informed Mr. Defren that she joined Applicant as Applicant's Vice President of Marketing.

15. Mr. Defren asked Ms. Fearman if Applicant would change its name and/or logo because of the similarity with Opposer's name. Ms. Fearman responded that she had already told at least one representative of Applicant that Applicant's "logo/all caps" was too similar to Opposer's name.

16. Applicant's use of Applicant's Mark has already caused confusion with Opposer's services under the SHIFT Mark. Even Opposer's customers have been confused by Applicant and Applicant's Mark, believing that Applicant is Opposer or is affiliated with Opposer. For example, on multiple occasions, Opposer's customers and associates have told Mr. Defren that they thought Applicant was Opposer and that they "Liked" Applicant's Facebook page believing that they were "Liking" Opposer. Also, in April 2013 several of Opposer's customers told Mr. Defren that they had seen Opposer's press regarding Salesforce.com, coincidentally one of Opposer's own clients. In fact, the subject of the press coverage, which included articles titled "SHIFT attacks Salesforce" and "SHIFT takes on Salesforce with its Open Marketing Cloud, consisting of 12 'best in class' apps" was Applicant's launch of a service that would compete with Salesforce.com, a client of Opposer.

COUNT ONE

Likelihood of Confusion

17. Opposer repeats and realleges each and every allegation set forth in paragraphs 1-16.

18. Applicant's Mark is extremely similar to the SHIFT Marks, and is applied to services closely related to services offered by Opposer which are promoted and sold or offered for sale in the same or similar channels of trade as those in which Opposer's services bearing the SHIFT Marks are promoted and sold. Applicant's Mark so closely resembles the Opposer's SHIFT Marks as to be likely to be confused therewith and mistaken therefor.

19. In view of the similarity between Opposer's SHIFT Marks and Applicant's Mark, and the related nature of the services of the respective parties, Applicant's Mark so resembles Opposer's SHIFT Marks previously used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake and deceive, and, in fact, actual confusion among Opposer's customers has occurred.

20. If Applicant is permitted to use and register Applicant's Mark for its services, as specified in the application herein opposed, confusion in the trade and public resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the Applicant's Mark and Opposer's SHIFT Marks. Persons familiar with Opposer's SHIFT Marks would be likely to believe that Applicant's services, which are closely related to the services rendered in connection with Opposer's SHIFT Marks, have their origin with Opposer and/or that such services are offered, sponsored or approved by Opposer or associated in some way with Opposer.

21. If Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

COUNT TWO

False Designation of Origin

22. Opposer repeats and realleges each and every allegation set forth in paragraphs 1-21.

23. Applicant's unauthorized proposed services bearing Applicant's Mark will constitute a false designation of origin and a false description or representation that Applicant's sale of such services is authorized by Opposer, and is thereby likely to confuse consumers.

24. Upon information and belief, Applicant intends to use the designation SHIFT with full knowledge that such designation is associated exclusively with Opposer and exclusively designates Opposer's services. Applicant's proposed acts of unfair competition will be willful and deliberate and with intent to reap the benefit of the goodwill and reputation associated with Opposer's SHIFT marks.

25. Applicant's proposed sale and distribution of services bearing Applicant's Mark, will violate Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

26. Opposer will be damaged if Application Serial No. 85/775,791 should issue to registration because Applicant will obtain statutory rights in the designation SHIFT.COM in violation and derogation of the established prior right of Opposer.

COUNT THREE

Falsely Suggests a Connection with Opposer

27. Opposer repeats and realleges each and every allegation set forth in paragraphs 1-26.

28. Opposer believes it will be damaged by registration of Applicant's Mark under Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the ground that Applicant's use and registration of the subject mark will falsely suggest a connection between Applicant and Opposer to the damage of Opposer and injury to the public, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a).

COUNT FOUR

Fraud on the U.S. Patent and Trademark Office

29. Opposer repeats and realleges each and every allegation set forth in paragraphs 1-28.

30. Opposer's SHIFT Marks are substantially identical to Applicant's Mark, as both parties' marks include the term SHIFT as their dominant element, and Applicant's Mark is applied to services closely related to services offered by Opposer which are promoted and sold or offered for sale in the same or similar channels of trade as those in which Opposer's services in connection with Opposer's Mark are promoted and sold.

31. At the time Applicant signed the Declaration, Opposer's SHIFT Marks were already in use in the United States in connection with the provision of integrated communications agency services.

32. At the time Applicant signed the Declaration, Opposer possessed clearly established rights in Opposer's SHIFT Marks superior to Applicant's rights because Opposer used the SHIFT Marks in connection with the provision of integrated communications agency services prior to Applicant's use of Applicant's Mark in connection with closely related services.

33. At the time Applicant signed the Declaration to register Applicant's Mark, it knew of Opposer's prior rights in the SHIFT Marks in connection with closely related services, because it had received from Opposer's Chief Executive Officer a Wall Post on Applicant's Facebook page, which, upon information and belief, Applicant deleted, a note via Facebook's private messaging service and an email that informed Applicant of Opposer's prior rights in the SHIFT Marks.

34. As a result of the foregoing, at the time Applicant signed the Declaration. Applicant had no reasonable basis for believing that confusion between Opposer's SHIFT Marks and Applicant's Mark would not be likely.

35. Despite the prior use of substantially identical marks used in connection with closely related services, Applicant submitted the Declaration and continued to prosecute the trademark application for Applicant's Mark. Applicant's Mark has been published in the Official Gazette.

36. Applicant knowingly made a material misrepresentation to the PTO to procure the registration of application Serial No. 85/775,791.

37. Said false statement was made with the intent to induce the PTO to grant Applicant a registration for Applicant's Mark, and reasonably relying upon the truth of said false statement, the PTO published the Applicant's Mark for opposition and will likely grant registration to Applicant's Mark.

38. Opposer has been and will be damaged by Applicant's Mark because Applicant has obtained rights in the designation SHIFT in violation and derogation of the established prior rights of Opposer.

39. If Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer, SHIFT Communications, Inc., prays that this Opposition be sustained and that the application Serial No. 85/775,791, for the mark SHIFT.COM for the services therein specified in International Class 42 be refused registration, and for such other relief as may be deemed just and proper.

Respectfully submitted,

By: /M. Carolina Avellaneda/
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Dated: April 29, 2013

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the original of the foregoing NOTICE OF OPPOSITION has been served on April 29, 2013, by regular mail, to Applicant's attorney of record at the following address:

John Paul Oleksiuk, Esq.
Cooley LLP
777 6th St N.W., Ste. 1100
Washington, D.C. 20001-3706

/Ellen Lyons/
Ellen Lyons